

Remarks

I. Support for Amendments

The foregoing amendments to the claims are fully supported in the specification as originally filed. Specifically, the amendment to claim 45 is supported in the specification at page 39, lines 13-27; and the amendment to claim 47 is sought to provide proper dependency therefor. Accordingly, these amendments do not add new matter, and their entry is respectfully requested.

II. Status of the Claims

By the foregoing amendments, claims 37-43, 50 and 51 have been cancelled without prejudice or disclaimer, and claims 45 and 47 have been amended. These amendments do not add new matter to the present application. Upon entry of these amendments, claims 45-49 and 52 are pending in the application, with claim 45 being the sole independent claim.

III. Summary of the Office Action

In the non-final Office Action dated January 18, 2001, the Examiner has made one objection to the specification and three rejections of the claims. Applicants respectfully offer the following remarks to overcome each of these rejections.

IV. The Objection to the Title of the Application

In the Office Action at Page 2, Section 2, the examiner has objected to the title of the invention as not being descriptive of the subject matter of the present divisional application, and has required the entry of a new title clearly indicative of the invention to which the present claims

are directed. By the foregoing amendments, the title of the present application has been amended to delete the words "Methods and" from the title as filed, since the claims of the present divisional are drawn to compositions (the corresponding method claims having been pursued in the parent application). In view of this amendment, Applicants respectfully assert that the objection to the title of the application has been fully accommodated; reconsideration and withdrawal therefore are respectfully requested.

V. *The First Rejection Under 35 U.S.C. § 102(e) Is Traversed*

In the Office Action at pages 2-3, section 4, the Examiner has rejected claims 37-42 and 45-52 under 35 U.S.C. § 102(e) as being unpatentable over Chenchik *et al.*, U.S. Patent No. 5,565,340 (Doc. Ref. A1 cited on the Form PTO-892 attached to Paper No. 3 ("the 892 form"); hereinafter "Chenchik"). By the foregoing amendments, claims 37-42, 50 and 51 have been cancelled, thus rendering moot the portion of this rejection that may have applied to these claims. Applicants respectfully traverse this rejection as it may be applied to the remaining claims.

Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984); *see also PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996) ("[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Applicants respectfully assert that Chenchik does not support a rejection of the invention as presently claimed under 35 U.S.C. § 102(e).

Claims 45-49 and 52 as currently presented are drawn to compositions comprising one or more restriction endonucleases and one or more polymerase inhibitors, which do not comprise nucleic acid molecules. In contrast, Chenchik does not disclose such compositions. To the contrary, all of the compositions disclosed by Chenchik contain nucleic acid molecules (specifically, PCR products). Chenchik therefore fails to expressly or inherently disclose every element of the invention as it is now claimed. Hence, under *Kalman* and *PPG Industries*, Chenchik cannot and does not anticipate the presently claimed invention. Reconsideration and withdrawal of this rejection therefore are respectfully requested.

VI. The Second Rejection Under 35 U.S.C. § 102(e) Is Rendered Moot

In the Office Action at pages 3-4, section 5, the Examiner has rejected claims 37-42 under 35 U.S.C. § 102(e) as being unpatentable over Scalice *et al.*, U.S. Patent No. 5,587,287 (Doc. Ref. B1 cited on the 892 form). By the foregoing amendments, claims 37-42 have been cancelled. Thus, this rejection has been rendered moot.

VII. The Rejection Under 35 U.S.C. § 103(a) Is Rendered Moot

In the Office Action at pages 5-6, section 7, the Examiner has rejected claims 42-43 under 35 U.S.C. § 103(a) as being unpatentable over Chenchik in view of Ahern (*The Scientist* 9(15):20 (1995)) (Doc. Ref. U1 cited on the 892 form) and the Stratagene Cloning Systems Catalog (Doc. Ref. V1 cited on the 892 form). By the foregoing amendments, claims 42-43 have been cancelled. Thus, this rejection has been rendered moot.

VIII. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: July 18, 2001

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600

Version with markings to show changes made

I. In the Title

Please amend the Title of the application as follows:

[Methods and] Compositions for Cloning Nucleic Acid Molecules

II In the Claims

(a) Claims 37-43, 50 and 51 are cancelled without prejudice or disclaimer.

(b) Claims 45 and 47 are sought to be amended as follows:

45. (Once amended) A composition comprising one or more restriction endonucleases and one or more polymerase inhibitors[.], wherein said composition does not comprise a nucleic acid molecule.

47. (Once amended) The composition of claim [46] 45, wherein said polymerase inhibitor is an antibody or a fragment thereof.